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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,923	06/27/2003	Helmut Bentivoglio	SCH-00069	8651
7590 12/28/2005			EXAMINER	
Warn, Burgess & Hoffmann, P.C.			NEGRON, ISMAEL	
P.O. Box 70098			ART UNIT	
Rochester Hills, MI 48307			PAPER NUMBER	
			2875	

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/607,923	<b>Applicant(s)</b> BENTIVOGLIO ET AL.	
	<b>Examiner</b> Ismael Negron	<b>Art Unit</b> 2875	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached Detailed Action.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed November 23, 2005 have been fully considered but they are not persuasive.

2. Regarding the Examiner's rejection of Claim 11 under 35 U.S.C. 103(a) as unpatentable over SCHULZ (U.S. Pat. 5,880,538) and DESMOND et al. (U.S. Pat. 5,820,245), the applicant argues that the proposed combination of references is not obvious since the references fail to suggest or provide motivation to combine them to obtain the claimed invention.

The applicant further argues that even if the combination was proper, it still fails to disclose or suggest all the limitations of the claims, specifically switches located inside the mirror housing. Desmond et al., the applicant argues, discloses the switches located on the exterior of the mirror housing.

The applicant even further argues that the affidavit under 37 C.F.R. 1.132 by Mr. Volker Zipf (one of the instant applicants) supported the unobviousness of the cited combination of references.

3. Regarding claims 12-22, the applicant present no additional arguments, except stating that such claims depend directly or indirectly from independent claim 11 and would be allowable when/if the independent claim is allowed.

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4. In response to applicant's argument that there is no suggestion to combine the references, the applicant is once again advised that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The applicant is also advised that there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and **the knowledge of persons of ordinary skill in the art**. *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, SCHULZ discloses a capacitance proximity switch which may be used as an actuating device for a variety of universal control applications (see column 1, lines 7-9). Applicant arguments characterizing the structure of SCHULZ as "a switch for exterior automotive applications" is not only unsupported, but clearly in error. One of ordinary skill in the art at the time the invention was made would have immediately recognized SCHULZ controlling windshield wipers and door locks were mere examples of the many application where the patented switch structure could be used, specially in light of SCHULZ disclosure in columns 1 and 2 (lines 44-67 and 1-33, respectively). Using the patented switch structure of SCHULZ would have flown naturally to one of ordinary skill in the art where activation of a circuit without actual physical contact was required or advantageous. SCHULZ even states such fact in column 2, lines 46-53.

Using the switch of SCHULZ for switching the reading lamps of the patented vehicle device of DESMOND et al. would have been obvious to one of ordinary skill in the art to be able to operate such lamps without actually touching them, such feature being specifically advantageous in low ambient light conditions (when small conventional switches operative portions are hardly visible), or when the vehicle was in motion (when small conventional switches operative portions are difficult to target).

5. Regarding applicant's surprising arguments that Desmond et al. discloses the switches located on the exterior of the mirror housing, the applicant is directed to figures 6, 9 and 10, where switches 27 and 29 are clearly shown within the mirror housing 11. It appears that the applicant is interpreting the operative portions of the switches 27 and 29, which do partially project outside the mirror housing 11, as being one and the same as the switches 27 and 29. Such interpretation is inaccurate.

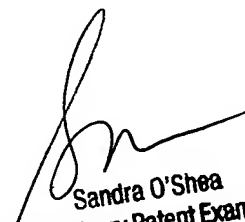
6. Regarding the affidavit under 37 C.F.R. 1.132, the applicant is once again advised that the affidavit filed August 18, 2005 is insufficient to overcome the rejection of Claim 11 under 35 U.S.C. 103(a) as unpatentable over SCHULZ (U.S. Pat. 5,880,538) and DESMOND et al. (U.S. Pat. 5,820,245) as set forth in the last Office action because: the affidavits merely provides a short summary of the disclosure of the cited references, and finally concludes that combining such references would not be obvious, without providing **facts or any rationale for the non-obvious opinion**. In addition, the affiant incorrectly characterizes the patented structure of SCHULZ as a switch for exterior vehicle applications.

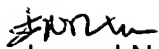
### Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (571) 273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.

  
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